

REMARKS

Applicants are in receipt of a Notice of Non-Compliant Amendment with regard to the matter captioned above. That paper was dated December 12, 2006, and a time period of one month from that date was imposed as a deadline for re-submitting the corrected section in compliance with the rules. It is submitted that the action taken hereby is timely and adequate to obviate the non-compliance cited by the examiner.

The AMENDMENT is hereby being resubmitted in its entirety, but with the amendments to the specification which the examiner referred to in his Communication dated December 12, 2006 (i.e. p. 1, lines 6-13) deleted.

The above amendments and following remarks are submitted in response to the pending Official Action of the Examiner mailed June 23, 2006. Having addressed all objections and grounds of rejection, claims 1-21, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has objected to Applicants' incorporation by reference. In response thereto, the specification has been amended at page 1, lines 6-13.

The Examiner has objected to the use of quotations about the term, "power". In response thereto, the specification has been amended as suggested by the Examiner.

The Examiner has objected to the use of "javascript" as opposed to "JavaScript". In response thereto, the specification has been amended as required.

The Examiner has objected to claims 2, 4, 9, 11, 18, 19, and 21, because he prefer the alternate spelling of "publicly" to Applicants' preference of "publically". In response thereto, the claims have been amended as requested.

The Examiner has apparently objected to claim 11 for some unknown reason. He has stated:

Examiner objects to the inconsistent informal function plus means invocation language found in claim 11(b), 11(c), and 11(d) in relation to the more formal "means for" found in 11(a).

This ground of objection is respectfully traversed as not understood. However, Applicants have reviewed claim 11 and deem it to be in proper form in accordance with 35 U.S.C. 112, sixth paragraph.

The Examiner has objected to claims 1, 2, 6, 16, 18, and 21, because "user terminal is not defined anywhere in the specification". In response thereto, claims 1, 2, 6, 16, 18, and 21 have been herewith amended to utilizes the term "terminal" which is defined in the specification at page 14, lines 10-15.

The Examiner has objected to claims 5, 10, 20, and 21 for the use of the term, "JavaScript". Though the Examiner's objection appears incomprehensible, the term has been removed from the objected claims.

Claim 11 has been rejected under 35 U.S.C. 101. Though the rejection is largely incomprehensible, the Examiner appears to allege that claim 11 is not drawn to statutory subject matter. To the extent understood, this ground of rejection is respectfully traversed. It appears that the Examiner has failed to examine claim 11 in accordance with MPEP 2181-2184.

Claims 1, 5, 6, 10, 11, 16, 20, and 21 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, claims 1 and 21 are rejected for claiming an operatively incomplete apparatus. This ground of rejection is respectfully traversed. It appears that the Examiner has improperly confused the breadth of claims 1 and 21 with the question of definiteness.

Claims 5, 10, 20, and 21 have been rejected in view of the term "JavaScript". In response thereto, this term has been removed from the claims as suggested by the Examiner.

Claims 1, 5, 6, 10, 11, 16, 20, and 21 have been rejected for use of the term "-based". This ground of rejection is respectfully traversed. Applicants' specification is replete with references to and material concerning to definition of the commonly used term, "object-based".

Claim 14 has been rejected in view of the use of the term "MAPPER". In response thereto, this term has been removed from claim 14 as suggested by the Examiner.

Claim 21 has been rejected in view of the term, "JavaScript like". In response thereto, this term has been removed in accordance with the suggestion of the Examiner.

Claims 1, 6, 11, and 21 have been rejected under 35 U.S.C. 102(b)¹ as being anticipated by U.S. Patent Application No. 2004/0098595, published in the name of Aupperle et al (hereinafter referred to as "Aupperle"). The ground of rejection is respectfully traversed as to the amended claims for the following reasons.

The standards for a finding of anticipation during examination are specified in MPEP 2131, which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection is respectfully traversed because "the identical invention" is not shown by Aupperle "in as complete detail as is contained in the claims" as is required by MPEP 2131.

Applicants' invention as disclosed and claimed provides a method and apparatus for requesting services from a legacy data

¹It is assumed that the Examiner means to reject under 35 U.S.C. 102(e).

base management system from a user terminal using standardized object-oriented command language which is incompatible with the legacy data base management system. This is accomplished by using the legacy data base management system to perform the required conversions using parameterized inputs defined in the incompatible standardized object-oriented command language.

For whatever reason, the Examiner has cited and sought to apply Aupperle, which is concerned with an integrated sign-on procedure. Thus, instead of a user performing data base functions using a data base management system as claimed, Aupperle sends user identification information to the disclosed server. To the extent that the Examiner cites conversions within Aupperle, these amount to mere conversions of data strings rather than the claimed conversion of "user requests". As a result of the lack of pertinence of this reference, the rejection of claims 1, 6, 11, and 21 can only be based upon clearly erroneous findings of fact and incorrect application of controlling law. Nevertheless, Applicants have herewith made slight amendments to these claims to more explicitly direct the reader's attention.

Claim 1, as amended, has four basic elements. The first element is "a terminal which generates a user request in a standardized object-based command language". In making his rejection, the Examiner cites Aupperle, Fig. 1 item 110, which is not a piece of hardware as claimed, but is apparently a software

module (see paragraph 0058). Surely, the Examiner does not consider a software module to be the same as a physical piece of hardware. Furthermore, the Examiner cites and misapplies paragraph 0088 to show further functionality of the claimed "terminal", wherein there is no showing that paragraph 0088 has anything to do with Fig. 1, item 110.

The second claimed element is "a legacy data base management system responsively coupled to said terminal which honors said user request by execution of a non-standardized command language to produce a result from a dataset". In making his rejection, the Examiner cites Aupperle, paragraph 0118, which mentions a "legacy host application". However, the Examiner ignores the remainder of the claim which requires the claimed "legacy data base management system" to be "responsively coupled to said terminal". Surely, the Examiner does not suggest that Aupperle discloses that the "legacy host application" of paragraph 0118 is somehow "responsively coupled to said terminal", as claimed. Furthermore, because Aupperle says nothing of a "dataset" associated with the "legacy host application" of paragraph 0118, the Examiner simply ignores the claimed limitation and again cites Fig. 17, a display page. Finally, the claim requires that the "legacy data base management system" honors the claimed user request. Nowhere does Aupperle suggest that the "legacy host application" of paragraph 0118 honors any user request as

claimed.

The third claimed element is "a conversion facility for conversion of said standardized object-based command language to said non-standardized command language". In making his rejection, the Examiner cites paragraph 0066. This citation discloses no association with Fig. 1, item 110, which the Examiner has equated with the claimed "terminal" and no association with paragraph 0118. Furthermore, paragraph 0066 has nothing to do with conversion of the claimed "command language" from one format to another.

As to the fourth claimed element, "a facility responsively coupled to said legacy data base management system which prepares said result for transfer to said terminal and which modifies said dataset if and only if specified in said service request", the Examiner cites disparate paragraphs 0007, 0009, and 0011, along with Figs. 1 and 17. It is truly confusing why the Examiner would consider these citations related as required by claim 1. Thus, it is assumed that the Examiner is simply trying to find the words of Applicants' claim without addressing its meaning.

As a result of Aupperle having none of the four elements of claim 1, the rejection of amended claim 1 is respectfully traversed.

Claim 6 is an independent method claim having five limiting steps. Aupperle has none of these five steps. Apparently, the

Examiner has not found the first step to be expressly disclosed by Aupperle, so the Examiner states:

HTML inherently includes JavaScript

This statement is clearly erroneous on its face. In addition it certainly does not comport with the requirements of MPEP 2112. Therefore, the first element of claim 6 is admittedly not found in Aupperle.

The second claimed element is "receiving said service request by said legacy data base management system". In making his rejection, the Examiner cites paragraph 0009, which says nothing of "receiving said service request" as claimed.

The third claimed element is "converting said service request in said standardized object-based command language into said non-standardized command language". In making his rejection, the Examiner again cites paragraph 0009 which discloses nothing of "converting" as claimed. Furthermore, the Examiner again bases his findings on "HTML includes JavaScript" which is clearly erroneous and incorrect as a matter of law for failure of the Examiner to comply with MPEP 2112.

In clearly erroneously finding the fourth element, the Examiner again cites paragraph 0009, which discloses nothing of the claimed "honoring said service request". The fifth claim element requires "modifying" a dataset. The Examiner cites paragraph 0018 which has nothing to do with this limitation. The

rejection of amended claim 6 is respectfully traversed.

Claim 11 is an independent apparatus claim having four "means-plus-function" limitations as correctly found by the Examiner. Nevertheless, he ignores his obligations under MPEP 2181-2184 in examining claim 11. As a result, he somehow equates the data window of Fig. 5 to the claimed "permitting means", a "legacy access screen" to the claimed "offering means", the illegal use of a URL within paragraph 0090 to the claimed "converting means", and Fig. 12G to the claimed "modifying means". To these clear errors of law, the Examiner again finds "inherency" without complying with MPEP 2112. Thus, the rejection of claim 11 is respectfully traversed as based upon clearly erroneous findings of fact and incorrect application of controlling law.

In rejecting claim 21, the Examiner makes many of the same errors discussed above. In addition, the Examiner makes additional errors. For example, in finding the claimed "facility", the Examiner states:

....which modifies said dataset if and only if
specified in said service request (inherently capable
with user security privileges).

Though quite cryptic, this statement is clearly erroneous (because Aupperle says nothing of the claimed "modifying") and is incorrect as a matter of law, because it does not meet the requirements of MPEP 2112. The rejection of amended claim 21 is

respectfully traversed.

Claims 1-10 have been rejected under 35 U.S.C. 102(a)² as being anticipated by U.S. Patent Application No. 2005/0044197, published in the name of Lai (hereinafter referred to as "Lai"). This ground of rejection is respectfully traversed for failure of Lai to meet the requirements of MPEP 2131.

Claim 1 is limited by "a facility responsively coupled to said legacy data base management system which prepares said result for transfer to said terminal and which modifies said dataset if and only if specified in said service request". Lai has no such facility "which prepares said result for transfer to said terminal and which modifies said dataset if and only if specified in said service request". Therefore, in making his rejection, the Examiner cites disparate paragraphs 0992, 0993, 1003 and 1004 of Lai. The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and further limits the coupling of the claimed "terminal". Even though the Examiner found the "terminal" of claim 1 to be disclosed in paragraph 0005, he finds the further limitations to the coupling to be in the totally unrelated Fig. 15. This is incorrect as a matter of law. The rejection of claim 2 is respectfully traversed.

Claim 3 depends from claim 2 and is further limited "wherein

²Again, the Examiner probably means 35 U.S.C. 102(e).

the user request specifies the dataset". To make his rejection, the Examiner arbitrarily cites paragraph 1123 which says nothing of the claimed limitation. Thus, the Examiner has impermissibly based his rejection on clearly erroneous findings of fact. The rejection of claim 3 is respectfully traversed.

Claim 4 depends from claim 3 and further limits the claimed coupling network. As explained above, Lai does not meet the limitations of claim 3 from which claim 4 depends. Therefore, Lai cannot meet the further limitations of claim 4. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and further limits the claimed "standardized object-based command language". To make his rejection, the Examiner again makes a finding of "inherency" without making the showings required by MPEP 2112. The rejection of claim 5 is respectfully traversed.

Claim 6 is an independent method claim having five key steps. The rejection of claim 6 is respectfully traversed as incomprehensible. For example, with regard to the first method step, the Examiner states:

- a. transmitting (see [1269] "transmit the transaction") a service request is a standardized object-based command language ([1269]) "SOAP" from said user terminal requesting access to said legacy data base management system (see [1015] "legacy FX"

Quite apart from Applicants' inability to understand the Examiner's position, it appears that the Examiner is simply

searching through the extensive text of Lai to find the words used in Applicants' claims. The rejection of amended claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 7 depends from claim 6 and further limited by "wherein said dataset is specified by said service request". Instead of identifying the claimed limitation, the Examiner appears intent on showing the disclosure of "a data base". The rejection of claim 7 is respectfully traversed for failure to address the claimed invention.

Claim 8 depends from claim 7 and further limits the claimed coupling network. As explained above, Lai does not meet the limitations of claim 7 from which claim 8 depends. Therefore, Lai cannot meet the further limitations of claim 8. The rejection of claim 8 is respectfully traversed.

Claim 9 depends from claim 8 and further limits the claimed coupling network. As explained above, Lai does not meet the limitations of claim 8 from which claim 9 depends. Therefore, Lai cannot meet the further limitations of claim 9. The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and further limits the claimed "standardized object-based command language". To make his rejection, the Examiner has again found "inherency" without making the showings required by MPEP 2112. The rejection of claim 10 is respectfully traversed.

Claims 11-13 have been rejected under 35 U.S.C. 102(a)³ as being anticipated by U.S. Patent Application Publication No. 2004/0260581, published in the name of Baranowski et al. (hereinafter referred to as "Baranowski"). This ground of rejection is respectfully traversed for failure of Baranowski to meet the requirements of MPEP 2131.

Claim 11 is an independent apparatus claim having "means-plus-function" limitations as correctly found by the Examiner. Nevertheless, he ignores his obligations under MPEP 2181-2184 in examining claim 11. As a result, he somehow ignores the claimed "permitting means", equates a "reverse auction" to the claimed "offering means", and finds that a "reservation" corresponds to the claimed "modifying means". Thus, the rejection of claim 11 is respectfully traversed as based upon clearly erroneous findings of fact and incorrect application of controlling law.

Claim 12 depends from claim 11 and is further limited by the claimed service request specifying the claimed dataset. In making his rejection, the Examiner states:

.....wherein said dataset ([0022]) "airline databases, car and hotel databases, train and bus databases, frequent flyer systems....., and the like") is specified by said service request ([0036] "air, car rental, hotel, rail, limousines, cruise lines, conference centers, ferries")

Though this statement is incomprehensible, it does seem apparent

³Again, the Examiner is incorrect concerning the statutory basis of his rejection. He apparently means 35 U.S.C. 102(e).

that paragraph 0022 does not disclose the claimed "dataset" and unrelated paragraph 0036 does not disclose the claimed specifying of the claimed dataset by the claimed service request. The rejection of claim 12 is respectfully traversed.

Claim 13 depends from claim 12 and is further limited by the claimed "means located within said permitting means for generating a second service request". Having not found the claimed "permitting means" in his rejection of claim 11, the Examiner somehow finds that "booking engine" 270 of Fig. 2 is located within the claimed "permitting means". This finding is unsupported by the prior art and is therefore clearly erroneous. The rejection of claim 13 is respectfully traversed.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baranowski in view of Classic MAPPER User's Guide 1.0 (hereinafter referred to as "Unisys"). This ground of rejection is respectfully traversed for failure of the Examiner to provide a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1) motivation to make the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings.

Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

The Examiner finds that Unisys discloses only proprietary hardware and software. Yet, in his only apparent attempt to show motivation, the Examiner states:

The motivation to combine arises from the desire to decrease the data isolation of the legacy system such as UCI from standards-based clients.

Therefore, this statement is clearly erroneous on its face and is specifically contradicted by the Examiner's own findings. Perhaps more important, the Examiner's statement provides no motivation to combine Unisys with Baranowski, but simply addresses reasons to combine Baranowski with Unisys. Thus, the Examiner's alleged finding of motivation is incorrect as a matter of law.

The second showing required by MPEP 2143 is that of reasonable likelihood of success. The Examiner admits that Unisys requires proprietary hardware and software. Therefore, he admits that there is no reasonable likelihood of success.

Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Unisys in view of Baranowski. This ground of rejection makes no sense, because claim 14 from which claim 15 depends has been rejected as unpatentable over Baranowski in view of Unisys. The rejection of claim 15 is respectfully traversed.

The Examiner discusses application of Baranowski to claims 16 through 20 but has stated no grounds of rejection. Therefore, claims 16-20 are deemed either found allowable over the prior art of record or incompletely examined.

Claim 21 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of something called "the apparatus of the CharlesSchwab.com trading system" (hereinafter referred to as "Schwab"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

In rejecting claim 21, the Examiner makes many of the same errors discussed above. In addition, the Examiner makes additional errors. For example, Schwab does not appear to be properly made of record. There is no disclosure in the record of "the apparatus" of the CharelesScwab.com trading system. Therefore, the rejection of claim 21 is improper, as a matter of law.

The Examiner also gratuitously states:

Other web-based brokerages can also be used in place of Charles Schwab such as ScotTrade.com and TD Ameritrade.com to render a comparable outcome.

Whereas a "comparable outcome" of failure to properly examine claim 21 is certainly the result, Applicants respectfully object to the discussion by the Examiner of alleged prior art which has not been properly made of record. The rejection of amended claim

21 is respectfully traversed.

Applicants acknowledge the Examiner's provisional rejection concerning obviousness type double patenting. As agreed, this matter is not yet ripe, because no claims have yet been allowed. However, Applicants will address the issue in due course.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-21 being the only pending claims.

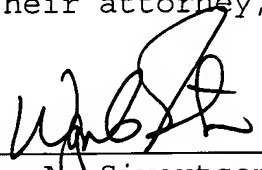
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Respectfully submitted,

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By their attorney,

Date January 12, 2007



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